

REMARKS

This application has been reviewed in light of the Office Action dated October 27, 2005. Claims 1-37 are presented for examination, of which Claims 1, 8, 15, 22, 29, 30, 31, 36 and 37 are in independent form.

The Amendment filed July 15, 2005 was objected to under 35 U.S.C. § 132(a) on the ground that it introduces new matter into the disclosure.

Claims 1, 8, 15, 22, 29-31, 36 and 37 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, and under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Office Action asserts that Applicants' claimed amendment regarding "wherein the changing means changes the size of the output image data before said transmitting means starts to communicate with the receiving apparatus" is non-enabling new matter.

In the Office Action, two independent sets of rejections of the claims under different interpretations were made. The first set of rejections (pages 4-9, paragraphs 11-14) apparently is based on an interpretation of the "changing means..." as "originating internally," while the second set of rejections (pages 9-14, paragraphs 15-16) apparently is based on an interpretation of the "changing means..." as "originating externally."

In the first set of rejections, Claims 1-33, 36 and 37 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,659,164 (Schmid); and Claims 34 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmid.

In the second set of rejections, Claims 1-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmid, in view of U.S. Patent No. 5,019,916 (Ogura).

On January 19, 2006, Applicants, through their undersigned attorney, conducted a telephonic interview with the Examiner. Applicants thank the Examiner for granting this interview. During the interview, Applicants' attorney and the Examiner discussed the objections and rejections under 35 U.S.C. §§ 132 and 112, as well as the prior art rejections. Applicants' attorney explained that the Summary of Invention section of the specification is a summary of what is described, in detail, in the Description of the Preferred Embodiment, and that the amendments made to that section were merely to conform the Summary of Invention section to the amended claims. Since any additions or deletions are supported in the Description of the Preferred Embodiment, the amendments and deletions to the Summary of Invention section do not add new matter. The Examiner stated that he understood and requested that Applicants identify, in their written response to the Office Action, the portions of the Description of the Preferred Embodiment that provide support for the additions and deletions. Applicants agreed. The Examiner also stated that, upon cursory review, it appears that the "wherein" clause that is the subject of the Section 112 rejections is supported by the specification on page 37, lines 15-26.

As to the prior art rejections, Applicants' attorney stated that, while Applicants do not clearly understand the basis for the two different interpretations of the "changing means...", Applicants believe that the claims are patentable over the prior art cited in either set of rejections. Applicants' attorney also explained that the "changing means" is internal to the information processing system. Applicants' attorney argued that the claims are allowable over Schmid for at least the reasons set forth below and that, even under the second set of rejections, the claims are allowable because Ogura fails to remedy

the deficiencies of Schmid. The Examiner stated that would reconsider the rejections based on Applicants' arguments, if made in a written response to the Office Action. The above constitutes the substance of the interview.

With respect to the objection under 35 U.S.C. § 132, as discussed above, the Summary of Invention section of the specification is a summary of what is described, in detail, in the Description of the Preferred Embodiment, and the amendments made to that section were merely to conform the Summary of Invention section to the amended claims. Since any additions or deletions are supported in the Description of the Preferred Embodiment, the amendments and deletions to the Summary of Invention section do not add new matter. Specifically, the phrase "intermediate data format", which was deleted from the Summary of Invention section in the July 15, 2005 Amendment, is supported on at least page 18 , lines 5-21, page 23, lines 16-21 and page 38, lines 8-14 of the specification.

Further, as discussed during the January 19, 2006 telephone interview, the following phrase, which was added to the Summary of Invention section in the July 15, 2005 Amendment, is supported on at least page 37, lines 15-26 of the specification: "and transmitting means for transmitting, from said multifunction apparatus to a receiving apparatus, the output image data processed by said changing means, wherein said changing means changes the size of the output image data before said transmitting means starts to communicate with the receiving apparatus."

In addition, the four paragraphs deleted on pages 3-5 of the July 15, 2005 Amendment (page 3, line 23 - page 6, line 10 of the specification) are merely method and computer readable memory paragraphs corresponding to the apparatuses described in the

second and third paragraphs of the Summary of Invention section (see pages 2-3 of the July 15, 2005 Amendment; page 2, line 18 - page 3, line 22 of the specification). These paragraphs were replaced with the phrase “and a method and computer readable memory storing program code therefor” in the corresponding “apparatus” paragraphs.

In view of the above, Applicants submit that no new matter has been added to the specification, and respectfully request that the objection to the amendment filed July 15, 2005 be withdrawn.

As to the rejection of Claims 1, 8, 15, 22, 29-31, 36 and 37 under Section 112, Applicants believe that those rejections are based on the same grounds as the Section 132 objection, and should be withdrawn for the same reasons as discussed above. In particular, the phrase “wherein the changing means changes the size of the output image data before said transmitting means starts to communicate with the receiving apparatus” is clearly described in the specification (see page 37, lines 15-26) as to enable one skilled in the art to make or use the invention, and is not non-enabling new matter. Applicants, therefore, respectfully request withdrawal of these rejections.

The prior art rejections will now be addressed. As discussed above, to the extent that Applicants understand the two interpretations provided in the Office Action, Applicants state that the “changing means...” is internal to the information processing system. However, Applicants submit that the claims are patentable under either set of rejections.

Claim 1 is directed to an information processing system having a multifunction apparatus, which is equipped with a facsimile function, and an information

processing apparatus. The system includes (1) temporary storing means for temporarily storing, on a storage medium, output image data composed of a plurality of pages as well as output configuring information; (2) acquisition means for acquiring output size of a prescribed page from the output configuring information of the output image data stored temporarily by the temporary storing means; (3) changing means for controlling the size of each page of the output image data based upon the output size acquired by the acquisition means such that all the pages coincide in size with the output size of the prescribed page; and (4) transmitting means for transmitting, from the multifunction apparatus to a receiving apparatus, the output image data processed by the changing means. The changing means changes the size of the output image data before the transmitting means starts to communicate with the receiving apparatus.

Schmid relates to automatically creating, identifying, routing and storing digitally scanned documents. In the Schmid system, pages of originals are scanned in, and each page of data is associated with corresponding page-specific data. The Office Action cites Fig. 3B, items 22 and 23 and column 4, lines 55-65 as disclosing changing the size of each page based upon the output size. Applicants respectfully disagree. The cited passages merely discusses, among other things, reading and recording the machine readable information (MRI) on the scanned cover page, “i.e., the routing and scanning configuration interfacing, etc. parameters, including resolution, brightness, contrast, mode (color, grayscale or bitonal), dither, page size, scan region and the like.” However, Applicants have found nothing in Schmid that would teach or suggest changing the size of the output

image data, much less changing the size of the output image data before said transmitting means starts to communicate with the receiving apparatus, as recited in Claim 1.

This is, in fact, admitted in the Office Action on page 10, line 1 (“Schmid does not specifically teach changing the size of each page based on the output size”) and in several prior Office Actions (see, May 18, 2005 Office Action, page 3, line 4; October 21, 2004 Office Action, page 3, line 11; March 18, 2004 Office Action, page 3, line 8; September 29, 2003 Office Action, page 3, line 12).

Accordingly, Applicants submit that Claim 1 is allowable over Schmid.

A review of the other art of record has failed to reveal anything which, in Applicants’ opinion, would remedy the deficiencies of the art discussed above, as references against Claim 1.

In particular, Ogura, which is cited as a secondary reference in the second set of rejections, does not remedy the deficiencies of Schmid. Ogura relates to a digital copier having a facsimile function, where the transmitting side changes the size of a document to be transmitted according to the paper size available at the receiving side, and based on size information transmitted by the receiving side. When an operator selects the transmission mode, a facsimile control transfers the receiving facsimile device’s telephone number to a network control, which calls the receiving facsimile device. As the line is established, the facsimile control executes a transmission control procedure to identify the receiving facsimile device’s receiving functions, including available paper size. If the size of the document to be transmitted is different from the size available at the receiving facsimile device, the document is transmitted after being changed in size.

However, nothing has been found in Ogura that would teach or suggest that “said changing means changes the size of the output image data before said transmitting means starts to communicate with the receiving apparatus,” as recited in Claim 1 (emphasis added). In Ogura, the size of the output image is changed after the transmitting facsimile device starts to communicate with the receiving facsimile device and based on the size information received from the receiving facsimile device.

Accordingly, even under the second set of rejections, Applicants submit that Claim 1 is patentable over Schmid and Ogura, whether considered separately or in any permissible combination (if any).


Independent Claims 8, 15, 22, 29, 30, 31, 36 and 37 recite features similar to those discussed above with respect to Claim 1 and, therefore, are also believed to be patentable over the cited prior art for the reasons discussed above.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,


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